

Remarks

We note with appreciation the telephone interview granted by the Examiner to discuss this and the parent application. The claims of both cases have been carefully amended based upon that discussion and in light of the Examiner's remarks in the Office Actions in an effort to address the Examiner's concerns and to place the claims in proper condition for allowance, or at least a final action thereon.

As discussed during the interview, this application has been pending for over almost five years and its parent application for almost six years, and are thus to be treated as "special" by the Office. MPEP 707.02. We greatly appreciate the Examiner's acknowledgement of this and her willingness to do her best to review both of these cases with dispatch.

The rejections under 35 USC 102(a) and 103(a).

Turning first to the substantive rejections, we respectfully traverse the Examiner's rejection of the solicited claims under 35 USC 102(a) and 103(a) as being unpatentable over Nadkarni (U.S. Patent No. 6,266,659), or Nadkarni in view of Haq et al. (U.S. Patent No. 6,275,812). Nadkarni and Haq fail to disclose, teach, or suggest at least two aspects of the claimed invention that are positively recited in the claims.

First, we first respectfully note that Nadkarni does not include the fundamental feature of all of the solicited claims of assigning an Intellectual Capital code to each of the assigned skills. While, as the Examiner correctly notes, Nadkarni does create hierarchical lists, the reference does not further disclose the use of a code, as positively recited in the solicited claims.

Nadkarni, as shown in Figure 5(a)-(c), inputs information using common word descriptions for each entry in a category. As Nadkarni states in C2:L45-52:

"Standardization is achieved through the use of system prompts directed to both the candidates when populating the database and the employers when formulating a search query. This ensures that both the candidate and the employer will use the same terminology, thus preventing the spelling, spacing, case, and most importantly, the language of the database from being an issue in the search. Therefore, accuracy and efficiency in selecting data to satisfy a query is facilitated." [emphasis added.]

All Nadkarni does is use forms that are populated with commonly used terminology that only allows the user to select a term from that list. While Nadkarni assigns these various skills to various categories in this manner, he does not code them as in the claimed invention. A reading of the Applicants' Specification (and the previously submitted iCap standard for that matter) illustrates the clear difference between simply using standardized terminology for various skills and creating an Intellectual Capital code. Moreover, the plainly different meanings of the terms "code" and "terminology" make this difference clear.

Another patentably distinct aspect of the claimed invention is that all of the solicited claims include the feature of adding at least one weighting factor to at least one of the Intellectual Capital codes, wherein the weighting factor contains a characteristic that allows it to be used to match and rank submitted skills. Based upon the Examiner's comments, the claims have been further amended in this application to positively recite this aspect of the invention in an effort to achieve an allowance of the solicited claims. Support may be found throughout the Specification, as discussed at length in the previously filed response.

We again respectfully note that the mere data of the length-of-time field of Nadkarni is not the weighting factor of the claimed invention. In Nadkarni, "a length-of-time field exists for each skill/category and allows for the summation of time-per-skill across various stretches of employment. In other words, the system can quantify length of experience for a particular skill over discontinuous periods of time. This feature is extremely beneficial since overall experience, not continuous experience, is of primary concern to most employers." (C2:L60-65.)

This is not a weighting factor, however, but merely a piece of data representing the length of time that an individual has spent working on a given skill. In other words, there is no mechanism in Nadkarni for *weighting* this value (i.e., representing the importance of this length-of-time in relation to the other skills so that it can be used by the system for a comparison of those skills). It is not the length-of-time value itself that is important, but how it is weighted in relation to other skills.

In sharp contrast to Nadkarni, in the claimed invention, a weighting factor is included in the Intellectual Capital code for a skill, which allows the Intellectual Capital code to be used to match and rank the individuals skills. This is nowhere disclosed, taught or suggested in Nadkarni and is not possible with his mere system of standardized terminology and stored raw data.

The solicited claims include the above-discussed and other various features not disclosed, taught, or suggested in Nadkarni. Accordingly, we respectfully request that the rejection be withdrawn.

We similarly traverse the rejections under 103(a) over Nadkarni in light of Haq et al. As discussed above, Nadkarni fails to disclose, teach, or suggest fundamental aspects of the claimed invention. Haq fails to satisfy the deficiencies of Nadkarni and their hypothetical combination still does not teach or suggest the claimed invention. Accordingly, we respectfully request that this rejection be withdrawn.

The provisional double patenting rejection.

The Examiner has provisionally rejected claims 1-7, 9-21, 23-29, 31-51, and 53-65 over several claims of Applicant's co-pending application 09/549,079 in view of Nadkarni (U.S. Patent No. 6,266,659) – and likewise the claims of that application over the claims of this one. Without acknowledgement of

the basis of the rejection, Applicant submits herewith a terminal disclaimer since this is the later filed application. Accordingly, we respectfully request that the double patenting rejection be withdrawn.

The rejection based upon 35 USC 112, first paragraph.

We respectfully traverse the rejection of claims 23-44 under the first paragraph of 35 USC 112 for non-enablement. As noted in the Specification, one clear example of a data source (indeed the example discussed at length in the Specification) is a relational database. As expressly stated in the Specification in paragraph [0039] "The data source of the present invention may comprise any number of data sources well known to those of skill in the art, such as relational databases or linked files."

As stated in MPEP 2106(B)(2), the specification should disclose how to configure a computer to possess the requisite functionality or how to integrate the programmed computer with other elements of the invention, unless a skilled artisan would know how to do so without such disclosure.

All of the positively recited aspects of the claimed data source are discussed in great detail in the embodiments of the invention disclosed in the Specification. The Specification discloses numerous examples of Intellectual Capital codes, a hierarchical list of Intellectual Capital categories, assigned codes to individual skills, and various weighting factors. By way of comparison, we note that the instant Specification provides much greater detail on how to structure a database than even the Nadkarni reference cited by the Examiner.

However, the claims have been amended in an effort to address the Examiner's concerns regarding structure to state expressly the inherent aspect of a data source that it is machine-readable and is stored on a machine-readable medium, and to further clarify that the data is stored in machine-readable form and has the structure that is positively recited in the claims. One example of such a machine, of course, is the computer based embodiments disclosed in the Specification. Thus, we respectfully submit that the claims are fully **enabling**.

Accordingly, we respectfully request that the rejection under 35 USC 112 be withdrawn.

The rejection based upon 35 USC 101.

We respectfully traverse the rejection of the solicited claims under 35 USC 101.

In regard to **claims 1-22**, while the Examiner does continue to acknowledge that the solicited claims did produce a concrete and useful result, the Examiner has now taken the position that that result was not tangible. The Examiner's concern appears to be that the solicited method could take place entirely within the human mind.

However, as discussed in the previously filed response, the Board in *Lundgren* made clear that a specific business process, not tied to any computer, can still produce a concrete, tangible, and useful result. We respectfully note that whether it may or may not be implemented within the mind is not really the issue.

Irrespective of this though, in the instant claims, the claimed method does **NOT** take place entirely within the human mind. For example, the Intellectual Capital codes and weighting factor are stored in a data source, which, as is well known to those of skill in the art and as discussed in the Specification, is a physical device, such as a database stored on a computer. Thus, the storage of the generated Intellectual Capital code and weighting factor in the data source clearly fixes them in a "tangible medium" as required under the Examiner's own test.

To make this clearer in an effort towards obtaining an allowance of the claims, the claims have been amended in this application to expressly recite this inherent aspect of a data source as being machine-readable. The claims have been even further amended to clarify that the submitted skills are received using a machine – another clearly tangible result.

Accordingly we respectfully request that the rejection be withdrawn.

In regard to **claims 23-44**, the Examiner has rejected these claims as non-statutory because "the applicant is claiming an apparatus without its structural parts needed to realize the apparatus' functionality." This appears to be tied to the Examiner's contention noted in connection with the rejection under 35 USC 112 that the claimed data source is not a "device." The Examiner does not provide any further explanation than this, nor does she cite any legal authority to support this as a valid basis for a rejection under section 101. However, it appears that the Examiner's contention is that the solicited claims are not statutory subject matter because they are not a properly claimed machine or article of manufacture. We respectfully disagree.

As noted in MPEP 2106, if a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product. See, e.g., *Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034-35; *Warmerdam*, 33 F.3d at 1361-62, 31 USPQ2d at 1760.

The claimed data source is in fact a statutory product and is not non-statutory non-functional descriptive material (as seems to be the Examiner's suggestion). The claimed apparatus clearly includes a hardware component (the data source), as well as functional software components that are "capable of causing functional change in the computer." MPEP 2106(IV)(B)(1)(a). A claimed machine-readable medium encoded with a data structure that defines structural and functional interrelationships between the

data structure and the computer software and hardware components which permit the data structure's functionality to be realized is statutory.

Thus, the recited claims clearly set forth the general structure of the claimed machine (e.g., computer) related product having expressly recited functional elements embodied in a machine-readable medium. The patent laws do not require that the claimed invention be limited to one described embodiment.

Because the requirements of 35 USC 101 are satisfied by the solicited claims, we respectfully request that the rejection under 35 USC 101 be withdrawn.

We respectfully submit that the solicited claims are patentable over the prior art and are in proper condition for allowance, which action is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, reading "Frank Cona". The signature is written in a cursive, flowing style.

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